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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,504	08/19/2003	Colin Hendrick	16045-4	5508

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EXAMINER

FRANKLIN, JAMARA ALZAIDA

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary

Application No.

10/643,504

Applicant(s)

HENDRICK, COLIN

Examiner

Jamara A. Franklin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Acknowledgment is made of the amendment filed on 10/19/05. Claims 1-31 are currently pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/05 has been entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 1-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/638,921. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the '921 application disclose:

a receptacle for receiving an intelligent ID card, the receptacle electrically communicating with the intelligent ID card by contacts or RF antenna;

a memory to hold stored data representative of features of the authentic user of the card;

a sensor for collecting data representative of features of the current user of the card; and

a microcomputer to compare the stored data with the sensed data to determine whether the current user is the authentic user.

The instant application claims the receptacle includes a cut way for viewing a portion of the ID card.

One of ordinary skill in the art would have readily recognized that a cut-out section would have been beneficial to the instant application to facilitate simple removal of the card from the card holder since the user could then visually locate the edge of the card. Therefore, it would have been obvious, at the time the invention was made, to modify the claims of the instant application for ease of use for the ID card holder user.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6, 9-20, 23 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmoft et al. (US 6,424,845) (hereinafter referred to as 'Emmof't') in view of Robertson (US 6,695,215) in view Barrett et al. (US 6,015,093) (hereinafter to as 'Barrett').

Emmof't teaches an intelligent ID card holder (hand-held communication device 10) to authenticate a user of an intelligent ID card (smart card 23) and method of using the intelligent ID card holder comprising (col. 1, line 66-col. 2, line 21):

a receptacle including two major surfaces with an opening formed between the two surfaces to accept the intelligent ID card into the sleeve;

a plurality of contacts exposed on the inside of the receptacle to make electrical contact with the intelligent ID card (col. 2, lines 14-17);

flash memory coupled to the microcomputer (transaction processor 20) to hold user feature data;

a user feature sensor (recognition device 14) mounted on the outside of the receptacle and coupled to the microcomputer to authenticate a user;

a programmed microcomputer mounted on or within one of the surfaces to control

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the intelligent ID card holder, and to compare a user's sensed feature to a stored user feature, wherein a positive comparison enables the intelligent ID card, or communicates authorization to an outside device or process based on the positive comparison (figure 2 and col. 2, line 61-col. 3, line 11);

the holder wherein the user feature sensor is a finger print sensor mounted on the outside of the receptacle and coupled to the microcomputer to authenticate a user;

the holder wherein the user feature is a chemical sensor mounted on the outside of the receptacle and coupled to the microcomputer to authenticate the user;

the holder further comprising a visual indicator to indicate a positive match;

the holder further comprising an LCD screen (LCD 12) to communicate information to the user;

the holder wherein the LCD screen displays labels in the vicinity of one or more smart keys to show the function of the one or more keys;

the holder wherein the LCD screen has touch sensitive areas and additionally serves as a key pad for user input;

the holder further comprising a radio frequency (RF section) and antenna (antenna 15) to transmit a signal to the outside device;

the holder wherein the signal is a secure code (col. 4, lines 20-22);

the holder wherein the outside device is a door lock;

the holder wherein the outside device is a building security system;

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the holder further comprising one or more keys (cursor controls 16 and 17) mounted on the outside of one of the surfaces of the receptacle and coupled to the microcomputer for user input;

the holder further comprising a microphone (microphone 13) on the outside of one of the surfaces of the receptacle and coupled to the microprocessor;

the holder further comprising a universal serial port (USB) connection to another computer;

the holder wherein the intelligent ID card is a smartcard; and

the method comprising permitting the user to log into a computer system (personal computer 36).

Emmofit lacks the teaching of the ID card receptacle including a cut away section for viewing substantially all of a side of the ID card.

Robertson teaches an intelligent ID card holder (read device 200) for an intelligent ID card comprising:

a receptacle for receiving an intelligent ID card (smartcard 100) wherein the receptacle includes a cut away section (window opening 244) for viewing a portion of the ID card (col. 4, lines 28-41).

One of ordinary skill in the art would have readily recognized that a cut-out section would have been beneficial to the Emmofit invention to facilitate simple removal of the card from the card holder since the user could then visually locate the edge of the card. Therefore, it would have been obvious, at the time the invention was made to modify the teachings of Emmofit with the aforementioned teaching of Robertson for ease of use for the ID card user.

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Emmof/Robertson lack the teaching of first and second rails and the teaching of a battery mounted within the ID card holder.

Barrett teaches an IC card holder for an intelligent ID card comprising:

a receptacle for receiving the intelligent ID card, the receptacle including first and second guide rails for supporting the intelligent card (see figures 8a-8d); and

a battery (battery 802) mounted within.

One of ordinary skill in the art would have readily recognized that the rails would have been beneficial to the Emmof/Robertson invention for securing the card while information is being communicated between the card and the reading device. Furthermore, one of ordinary skill in the art would have readily recognized that a battery would have been beneficial to the Emmof/Robertson invention for providing direct power to the ID card holder so that the ID card holder does not have to rely on outside power sources to function properly. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Emmof/Robertson with rails of Barrett to ensure that proper communication of information takes place and to allow the ID card holder to independently power itself.

6. Claims 7, 8, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmof/Robertson/Barrett as applied to claim 5 above, and further in view of Bjorn et al. (US 6,125,192) (hereinafter referred to as 'Bjorn').

The teachings of Emmof/Robertson/Barrett have been discussed above.

Emmof/Robertson/Barrett lack the teaching of the user feature sensor being a camera sensor.

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Bjorn teaches a user feature being a camera sensor mounted on the outside of a receptacle and coupled to a microprocessor to authenticate a user (col. 10, lines 46-61); and

wherein the camera is a CCD camera.

One of ordinary skill in the art would have readily recognized that the camera sensor is just one of a variety of sensors that may be utilized to uniquely identify a user. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Emmoft/Robertson/Barrett with the camera sensor as taught by Bjorn to facilitate the identification of the user.

7. Claims 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmoft in view of Clark (US 4,636,622).

The teachings of Emmoft have been discussed above.

Emmofl lacks the teaching of transmitting the sensed feature to a remote computer.

Clark teaches a method of using an intelligent ID card holder to authenticate a user of an intelligent ID card comprising:

sensing a feature of the user;

transmitting the sensed feature to a remote computer located remote to the ID card holder; and

comparing the sensed feature to a stored image of the user feature, the stored image being stored at the remote computer (col. 2, line 62-col. 3, line 17).

One of ordinary skill in the art would have readily recognized that allowing the Emmoft invention to transmit the sensed feature to a remote computer would have been beneficial for

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ensuring that the stored feature is maintained in a stable environment. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Emmoft with the aforementioned teaching of Clark to guarantee that a comparison can be made.

Response to Arguments

8. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

New rejections have been applied to independent claims 1, 5, and 31, and therefore dependent claims 2-4 and 6-23 in light of the newly amended limitation citing "the receptacle also including first and second rails for supporting the intelligent ID card".

In response to the argument regarding the rejection of claims 24-30, the examiner submits that, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the Emmoft and Clark references are relied upon together to form the 35 U.S.C 103(a).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

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In this case, the motivation to combine the Emmoft and Clark reference lie in knowledge generally available to one of ordinary skill in the art.

Conclusion

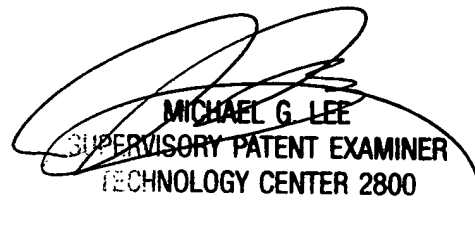
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (571) 272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jamara A. Franklin
Examiner
Art Unit 2876

JAF
November 19, 2005


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